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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/983,041	10/22/2001	Atsushi Shibuya	PF-2894/NEC/US/mh	8200

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EXAMINER
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SHAH, KAMINI S

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/983,041

Applicant(s)

SHIBUYA, ATSUSHI

Examiner

Kamini S Shah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2001 and 23 August 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/02, 2/04, 8/04</u> | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Objections***

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 44-57 been renumbered as 43-57.

However, the dependency for the old numbered claims 47, 49-52 and 55-57 also needs to be renumbered. They are renumbered as follows:

Claim 43 depends on claim 39

Claim 44 depends on claim 39

Claim 45 depends on claim 39

Claim 46 depends on claim 45

Claim 48 depends on claim 47

Claim 49 depends on claim 48

Claim 50 depends on claim 49

Claim 51 depends on claim 48

Claim 52 depends on claim 48

Claim 53 depends on claim 48

Claim 54 depends on claim 48

Claim 55 depends on claim 54

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1, 10-14 recites the limitation "said terminal device" in lines 10-11. There is insufficient antecedent basis for this limitation in the claim. Claim 1 defines "a plurality of terminal devices" but there is no definition of a single "terminal device" providing antecedent basis for "said terminal device".

In claim 35, there is no antecedent basis for "said communication unit"

4. Independent claims 1, 16, 29, 38, and 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claimed proposed invention, as a whole, which here refers to the common subject matter of independent claims, is not clearly defined. In claim 38, which appears to be the broadest claims and recites the common subject matter of all independent claims, it is not clear what is meant by the "retrieval of information" or "retrieval condition". In the context of the embodiment of the invention, is the "information" that is retrieved an email, or a keyword in an email, or a section of the email in which to look for keywords, or an indication from the email that a keyword is present in the email, or a keyword retrieved from a keyword table, or something else? Further, does the "retrieval condition" put conditions on the way the "retrieval of information" is conducted, or is it some other condition that is retrieved (in which case it is poorly named)? These

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uncertainties cast doubt on the scope of the invention and so a full examination of claimed invention is not possible until claims are amended to clearly define the invention.

5. Claims 38, 39 and 47 and 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Is the "at least one retrieval condition" provided by the "at least one table" with the "at least one corresponding display method", all defined in claim 39, the same as the "at least one retrieval condition" and "at least one display method", defined in claim 38? A link between these 'retrieval conditions' and 'display methods' is not made in claim 39 (i.e. by referring to the "said ..."), so confusion exists in claim 39 and later appendant claims when referring to "said retrieval condition" and "said display method" - which "retrieval condition" or "display method" is being referred to? The "retrieval condition" and "display method" of claim 38 or claim 39?

In claims 47 and 48, the same obscurity as that outlined above exists.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1-55 are rejected under 35 U.S.C. 102(e) as being anticipated by GB 2356956

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding to claimed invention as best understood, GB 2356956 clearly discloses communication section 24 connected to electronic mail control section inherently including processing unit for transferring and receiving information – e-mail. A display section 23 connected to electronic mail section or can be called as processing unit for displaying information, an operation unit as can be seen as telephone control section 24 for operating terminal device such as portable phone terminal. A memory unit electrically coupled to processing unit for storing at least table, such as email terminal

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includes a display section, a conversion dictionary which stores sets of character string and a pictograph, a receiving section and a control section and display pictograph mixed sentence as in page 7, lines 2-21.

Regarding to claims 2-8, and 10-11, GB 2356956 discloses various claimed features in the display section 23 of the system including font data table, display of a reception e-mail as claimed displaying information and table including necessary data for displaying information, see page 16, lines 22- 27 and page 17, lines 1-19.

Regarding claims 12 and 13, GB 2356956 teaches first functional block as telephone control section 25 connected with input section 22 for performing transmission control and reception control; second function block is disclosed as display section 24 and the input/output section for displaying information corresponding character pattern; third functional block is disclosed as electronic mail control section 26 for carrying out the control of general functions relating to the transmission and reception of the electronic mail.

Regarding claims 14 and 15, GB 2356956 discloses portable phone including Kana-Kanji conversion section 27 having processing unit, memory for storing computer program such as searching for phonetic expression from the phonetic table and then storing pictograph in the record of word table see pages 19, lines 3 thru page 21, line 20.

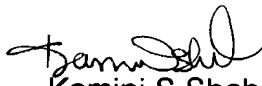
Regarding claims 16-54, claims recite similar subject matter as claims 1-15 therefore rejected for the similar reasoning.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamini S Shah whose telephone number is 571-272-2279. The examiner can normally be reached on IFP.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack B Harvey can be reached on 571-272-3896. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Kamini S Shah  
Primary Examiner  
Art Unit 2142

KSS